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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/031,628 | 05/10/2002 | Philip Blenkinsop | 124-00108 | 8288 |

26753 7590 09/30/2004

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| EXAMINER |
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KEENAN, JAMES W

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| ART UNIT | PAPER NUMBER |
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3652

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/031,628 | Applicant(s) BLINKINSOP, PHILIP | |
| | Examiner James Keenan | Art Unit 3652 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The drawings are objected to because figures 4 and 5 each comprise separate figures which must be labeled (and referred to in the specification) as such. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. Applicant's comment regarding the claim numbering is correct. An action on the merits of claims 1-10 follows.

3. Claims 3 and 10 are objected to because of the following informalities: --a-- should be inserted before "retaining". Appropriate correction is required.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 6, 7, 8; and 10, there is no clear antecedent basis for a particular "tray" or "port" (note "at least one tray" and "at least one ... port" in lines 2 and 3);

and line 9, it is not clear what is meant "movement of a container storage in the ... hole" (perhaps applicant meant *stored*).

In claim 9, it is not clear what is meant by "and/or insertion".

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Barcia et al (US 3,174,645, previously cited).

Barcia shows a storage and retrieval system comprising bin 12 (tray) with plural chambers 14 (storage holes), gas supply port 34, and gas supply manifold (labeled AIR), wherein the tray can be moved relative to the manifold such that a selected

storage hole can be aligned with the port to supply gas to the selected hole to move an article 10 in the hole to a retrieval position. Although the article is not a container, this is not a positively recited structural limitation but merely a statement of intended use. Since the apparatus of Barcia could be used, without modification, for a container, it is a proper anticipatory reference. Note column 6, lines 61+.

Re claim 3, note portion 16 of the hole which retains the article therein.

Re claim 9, the air pressure can be controlled for ejection or insertion of an article.

8. Claims 1-6 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Grabowski et al (US 3,334,785, previously cited).

Grabowski shows a storage and retrieval system for cells 19, 20 (containers), comprising storage trays 1-9 each having plural storage holes therein as clearly seen in figure 1, gas supply ports 26, 39, 41, and gas supply manifold 27, wherein the trays can be moved with respect to the manifold (such as tray 5 in figure 1) to align a selected storage hole with a port such that gas can be applied to the selected hole through the port to allow a container in the selected hole to be moved to a retrieval position. Note that pressurized gas from below the trays, vacuum from above the trays, or a combination thereof, may be utilized as the means of moving the containers.

Re claim 3, see figure 2.

Re claim 5, note through ports 12-15.

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9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grabowski et al in view of Kohler (US 2,904,215, previously cited).

Grabowski does not show the trays to be circular or rotatable.

Kohler shows a circular tray which can be rotated such that a selected article can be moved to a retrieval position. However, Grabowski does state that any suitable means can be used to move the trays (col. 3, lines 21-24).

It would have been obvious for one of ordinary skill in the art at the time of the invention to have modified the apparatus of Grabowski such that the trays were circular and rotated to a selected position, as shown by Kohler, as this would simply be an art recognized alternate equivalent means of storing articles in trays and retrieving same, particularly in view of Grabowski's disclosure of non-criticality.

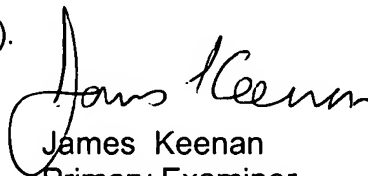
11. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Keenan whose telephone number is 703-308-2559. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on 703-308-3248. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James Keenan
Primary Examiner
Art Unit 3652

jwk

9/23/04